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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,336	08/19/2003	Mark H. Nicholls	12724.00009 (Nicholls et	3965
1342	7590	09/02/2004	EXAMINER	
PHILLIPS LYTTLE LLP			WONG, ERIC K	
INTELLECTUAL PROPERTY GROUP				
3400 HSBC CENTER			ART UNIT	
BUFFALO, NY 14203-3509			2883	
			PAPER NUMBER	

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/643,336

Applicant(s)

NICHOLLS ET AL.

Examiner

Eric Wong

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to ^{application} communication(s) filed on 19 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 3-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-2, drawn to turf with optical fibers, classified in class 362, subclass 559.
 - II. Claims 3-13, drawn to a method of marking a surface, classified in class 385, subclass 147.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the turf can be made by light sources in housings or filaments inserted in the surface.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Rowland Richards on 8/26/04 a provisional election was made without traverse to prosecute the invention of the method of marking a surface, claims 3-13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-2 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Inventorship

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 3 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent Number 4,310,974 to Gdovin et al.

Gdovin et al. discloses in figures 3 and 9, a method of marking a surface comprising the steps of :

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- Providing a light source (49);
- Providing a surface to be marked (10a);
- Providing a base supporting said surface to be marked (ground);
- Providing an optical material capable of illumination by said light source (45);
- Positioning said light source such that it is not between said surface and said base (light source 49 is positioned at a remote location).
- Configuring and arranging said optical material, said surface and said light source such that illumination of said optical material is visible on said surface; and
- Illuminating said optical material with said light source.

As to claim 9, the protruding fiber may be polished, ground or angled to provide unidirectional light, omnidirectional light or any other variation in directionality of the output light (column 5, lines 44-47).

9. Claims 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent Number 6,082,886 to Stanford.

Stanford discloses a method of manufacturing a surface, comprising the steps of:

- Providing an optical material (20);
- Providing a surface (14);
- Arranging said optical material such that it extends above the surface and
- Trimming said optical fibers such that it is flush with the surface (column 6, line 5).

As to claim 9, the surface is concrete (column 4, line 9).

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As to claim 11, the fibers are most often made in concrete via casting which is a step before hardening of concrete (Background of Invention)

As to claims 12-13, layer 14 in figure 3 is added on top of the layer containing the optical fibers.

10. Claims 4-8 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent Application Publication 2003/0113081 to Melby.

As to claims 4-7, Melby discloses in the abstract and figures 1-7, a method of manufacturing artificial turf comprising the steps of:

- Providing a primary backing layer (2);
- Providing artificial fibers (Paragraph 18);
- Providing optical material;
- Threading said artificial fibers through primary backing layer;
- Threading optical material through said primary backing layer and between said artificial fibers (The optical fibers of Melby are interweaved with artificial fibers and are oriented in many different directions as depicted in figures 1-4).

As to claim 8, depending on the application, the optical threading may be threaded at anytime (paragraph 43).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. United States Patent Number 6,398,399 to Neophytou for a fiber optic roadway guidance system.

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- b. United States Patent Number 6,652,132 to Hsueh for a fiber optic based plant box.
- c. United States Patent Number 6,116,751 to Remp for a lighted landscaping stone.
- d. United States Patent Number 4,884,865 to Grise for a fiber optic underfloor covering.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Wong whose telephone number is 571-272-2363. The examiner can normally be reached on Monday through Friday, 830AM - 430PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank Font can be reached on 571-272-2415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EW



Brian Healy
Primary Examiner